

Appl. No. 10/647,814
Examiner: Solak, Timothy, Art Unit 3746
In response to the Office Action dated January 10, 2005

Date: May 10, 2005
Attorney Docket No. 10111953

REMARKS

Responsive to the Office Action mailed on January 10, 2005 in the above-referenced application, Applicant respectfully requests amendment of the above-identified application in the manner identified above and that the patent be granted in view of the arguments presented. No new matter has been added by this amendment.

Present Status of Application

Claims 1, 2 and 5-8 are pending in the application. Claims 1-2 are rejected under the judicially created doctrine of double patenting over claim 14 of U.S. Patent No. 6,793,469. Claims 2, 5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Feldman (U.S. Patent No. 5,890,882). Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owen et al (U.S. Patent No. 4,678,014). Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feldman in view of Choy et al (U.S. Patent No. 5,605,482).

In this paper, the specification is amended to better reflect the claimed embodiments. Furthermore, a terminal disclaimer is filed to overcome the double patenting rejections.

Reconsideration of this application is respectfully requested in light of the remarks contained below.

Double Patenting Rejections

Claims 1-2 are rejected under the judicially created doctrine of double patenting over claim 14 of U.S. Patent No. 6,793,469. Applicant has attached hereto a terminal disclaimer under 37 C.F.R. 1.321 to obviate the double patenting rejection over U.S. Patent No. 6,793,469. The disclaimer is made solely for the purpose of advancing the prosecution of the application and should not be construed as an admission with respect to the merits of the rejection. Withdrawal of this rejection is respectfully requested.

Rejections Under 102(b)

Claims 2, 5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Feldman. The rejections are respectfully traversed for the reasons that follow.

Feldman teaches an inflator with drop-in batteries and universal adaptors. The inflator includes an adaptor housing 2, a transition adapter structure 50, and adapters 38 and 38' of varied sizes. The adapters are tethered to the transition structure and a desired adapter may be selectively fitted thereto according to the needs of the user. Opening 46 of adapter 38 is received in valve 52 of a bladder 54 to allow delivery of air to the bladder. See column 3, line 8 to column 4, line 53 and Fig. 6 of Feldman.

Feldman does not teach or suggest an inflatable product including an inflatable body, a socket built in the inflatable body, and an electric pump, including a pump body and an air outlet, connected to the socket to pump the inflatable body, wherein the pump body is wholly or partially located in the socket, as recited in claim 2.

MPEP 2131 prescribes that to anticipate a claim, a reference must teach every element of the claim. In this regard, the Federal Circuit has held:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 2 recites an inflatable product including an electric pump, wherein the electric pump includes a pump body and an air outlet. Claim 2 further recites that the pump body is wholly or partially located in the socket.

In the rejection of claim 2, the Examiner relies upon the composite structure of the inflator housing 2, the transition adapter structure 50, and the adapter 38 as the "pump body" recited in claim 2. See page 3 of the office action. On page 5 of the office action, the Examiner provides the following reasoning to support the position that adapter 38 is a part of the "pump body":

With respect to the applicant's contention, namely that adaptor 38 is not part of the pump body, the unity [or] diversity of parts does not patentably distinguish a structure. The object of [the] Feldman invention is to inflate bladder 54 and absent the adaptor the intended objective could not be accomplished. Whether structural elements 2/50/38 are integral or separate parts, they still form a "pump body" which is inserted, at least "partially" into a socket.

The Examiner thus appears to construe the claim term "pump body" to include every part of an electric pump necessary to accomplish the objective of inflating a bladder. Based on this construction of the term, a switch or power cord would also be a part of the "pump body" of an electric pump because such parts are necessary to accomplish the objective of inflating a bladder. On this construction, if air were pumped into the bladder via a detachable rubber hose, the detachable rubber hose would also be a part of the "pump body" because it is necessary to accomplish the objective of inflating a bladder. Indeed, every functional element of an electric pump would be part of the pump body, effectively eliminating the distinction between the terms "electric pump" and "pump body" as recited in claim 2.

It is Applicant's view that the rejection depends upon a construction of the claim that conflicts with the broadest reasonable meaning of "pump body" in light of the specification. Namely, as recited in claim 2 and described in the specification, the "pump body" is one element of an electric pump. Given the plain meaning of the words as read in light of the specification, this element refers to a body that contains a pump. It does not refer to the entire electric pump, or to every part of an electric pump necessary to accomplish the objective of inflating a bladder.

Feldman's inflator includes an *inflator housing*, a transition structure, and an adapter. Feldman himself distinguishes between the inflator housing and the adapter, describing them as separate components of a composite structure. See column 4, lines 44-46 of Feldman. In

Feldman, the pump is disposed within the inflator housing, not the adapter. As shown in Fig. 6 of Feldman, the inflator housing is not wholly or partially located in valve 52. Only the adapter is located in valve 52.

In contrast, claim 2 recites an electric pump that includes a **pump body** and an air outlet, wherein the **pump body** is wholly or partially located in a socket. This feature, which provides benefits such as stability of the electric pump when pumping the inflatable body, is neither taught nor suggested by Feldman.

For at least these reasons, it is Applicant's belief that claim 2 patentably distinguishes over Feldman. Insofar as claims 5, 6 and 8 depend from claim 2, it is Applicant's belief that these claims also patentably distinguish over Feldman. Withdrawal of this rejection is respectfully requested.

Rejections Under 103(a)

Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owen et al. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feldman in view of Choy et al. The rejections are respectfully traversed for the reasons that follow.

Owen et al teach an inflating/deflating device including a reversibly positionable, detachable nozzle 144, a connector portion 149, and a molded housing 26 in which is disposed an impeller for propelling air. When inflating or deflating an inflatable article, connector portion 149 of nozzle 114 is received into tubular portion T of the fill valve of the inflatable article. See column 6, line 22 to column 7, line 19 of Owen et al.

Owen et al do not teach or suggest an inflatable product including an inflatable body, a socket built in the inflatable body, an electric pump, including a pump body and an air outlet, connected to the socket to pump the inflatable body, wherein the pump body is wholly or partially located in the socket, and a connector provided at a predetermined position of the electric pump for connecting an external power to actuate the electric pump, as recited in claim 1.

MPEP 2142 reads in part:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In connection with the third criteria, MPEP 2143.03 goes on the state:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Examiner relies upon the composite structure of nozzle 144, connector portion 149, and molded housing 26 as the "pump body" recited in claim 2. For the same reasons described in the traversal of the rejections over Feldman, it is Applicant's view that the rejection depends upon a construction of the claim that conflicts with the broadest reasonable meaning of "pump body" in light of the specification.

As in the case with Feldman, the Examiner appears to rely upon reading the "structure" of a single element of the electric pump recited in claim 1 onto the "structure" of the entire inflating/deflating device of Owen et al in order to support the position that the "pump body" is located in a socket. This approach conflicts both with the distinction between the "electric pump" and "pump body" recited in claim 1 and described in the specification, and the broadest reasonable meaning of "pump body" in light of the specification.

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Owen et al's device includes a *molded housing*, a connector portion, and a nozzle. In Owen et al, the pump is disposed within the molded housing, not the nozzle. Furthermore, as shown in Fig. 8 of Owen et al, the molded housing is not wholly or partially located in tubular portion T of the fill valve. Only the nozzle is located in tubular portion T of the fill valve.

In contrast, claim 1 recites an electric pump that includes a *pump body* and an air outlet, wherein the *pump body* is wholly or partially located in a socket. This feature, which provides benefits such as stability of the electric pump when pumping the inflatable body, is neither taught nor suggested by Owen et al.

For at least these reasons, it is Applicant's belief that claim 1 patentably distinguishes over Owen et al. Insofar as claim 7 depends from claim 1, it is Applicant's belief that this claim also patentably distinguishes over Owen et al. Withdrawal of this rejection is respectfully requested.

With respect to the rejection of claim 6 over Feldman in view of Choy et al, it is Applicant's belief that Feldman does not disclose of the limitations of claim 2. Applicant therefore submits that claim 6 is allowable by virtue of its dependency from claim 2. For this reason, the Examiner's arguments in connection with this claim is considered moot and will not be addressed here.

Conclusion

The Applicant believes that the application is now in condition for allowance and respectfully requests so.

Respectfully submitted,



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